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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,974	11/22/2000	Richard E Rowe	IGTIP045/P-477	1552
22434	7590	12/30/2003	EXAMINER	
BEYER WEAVER & THOMAS LLP			NGUYEN, BINH AN DUC	
P.O. BOX 778			ART UNIT	PAPER NUMBER
BERKELEY, CA 94704-0778			3713	

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11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/718,974	ROWE, RICHARD E	
	Examiner Binh-An D. Nguyen	Art Unit 3713	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.			
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 			
Status			
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>16 October 2003</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is FINAL. 2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			
Disposition of Claims			
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>16-40</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>16-40</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>			
Application Papers			
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input checked="" type="checkbox"/> The drawing(s) filed on <u>22 November 2000</u> is/are: a)<input checked="" type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>			
Priority under 35 U.S.C. §§ 119 and 120			
<p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>			
<p>* See the attached detailed Office action for a list of the certified copies not received.</p>			
<p>13)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p>			
<p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.</p>			
Attachment(s)			
<p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</p>		<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____ .</p>	

DETAILED ACTION

1. The Amendment filed in Paper No. 10, October 16, 2003 has been received.

According to the Amendment, claims 1-15, and 41-58 have been canceled; and claims 16, 23, 27, 32, and 35 have been amended. Currently, claims 16-40 are pending in the application. Acknowledgment has been made.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery (6,564,995) in view of Acres et al. (5,752,882).

Montgomery teaches a terminal (82) (Fig.8) and for executing an application-selection application with the aid of a smart card (20), comprising: a terminal (82) having master controller (micro-controller 86) to control the application on the terminal using (a) first application instructions (Figs. 5C-6D) generated by a processor (72) on the smart card and (b) second application instructions generated by the master controller (micro-controller 86) (6:10-7:29; 3:29-4:67); and a smart card reader (7:1-12) providing a communication interface between said smart card and a master controller (micro-controller 86)(Figures 2, 7, and 8); receiving a signal indicating a smart card has been inserted in a smart card reader on the terminal; establishing communications with the

Art Unit: 3713

smart card; receiving application instructions from at least one of a plurality of applications executed by a processor on the smart card; and presenting an application on the terminal using the applications from the smart card and using applications generated by the master controller (micro-controller 86) on the terminal; authenticating the smart card; receiving a list of applications available on the smart card from the smart card; selecting a application from the list of applications and requesting the smart card to execute the selected application (Figure 5B); application configuration information consisting of a application type; sending application information to the smart card; downloading an application stored on the smart card and executing said application on the terminal (6:6-7:46); downloading applications stored on the smart card and executing said application on the terminal. See also, Figures 1-8 and columns 1-7.

Montgomery does not explicitly teach the limitations of: a gaming machine having master game controller, generating a game of chance on the gaming machine, wherein the gaming machine is operable to receive the smart card in the smart card reader from a game player playing the game of chance on the gaming machine (claims 16 and 27); game instructions specified a progressive game (claim 19), a pay-table (claim 20), and a bonus game (claim 25); the speaker outputs audio components stored in a memory on the smart card (claim 22); the graphical display outputs graphical components stored in a memory on the smart card (game applications) (claim 24); the gaming instructions include game configuration information (claim 32); game component includes at least one of a graphical game component and an audio game component (claim 33); in response to the gaming instruction received from the smart card, communicating with a

remote game server (claim 35). Acres et al., however, teaches a gaming machine for executing a game play with the aid of smart a card (120), comprising a master game controller, generating a game of chance on the gaming machine (2:50-3:65; 6:29-65), wherein the gaming machine is operable to receive the smart card in the smart card reader from a game player playing the game of chance on the gaming machine (1:33-48; 14:30-53; 20:30-43; 26:55-29:32); game instructions specified a progressive game, a pay-table, and a bonus game (3:2-18); the gaming instructions include game configuration information; game component includes at least one of a graphical game component and an audio game component; in response to the gaming instruction received from the smart card, communicating with a remote game server. See Figures 1-8 and 20-34; and columns 1-3, 6-9, 12-20, and 23-37.

Note that, the limitations of gaming machine further comprising a network communication interface wherein the smart card communicates with a game service server using said network communication interface (claim 17); a graphical display (claim 23); the game service server is selected from the group consisting of an account server, a bonus game server, a progressive server, a player tracking server and a cashless system server (claim 18); gaming machine comprising a speaker (claim 21); game play information is for a group of gaming applications consisting a video black jack game, a video slot game, a mechanical slot game, a video poker game, a video keno game, a video pachinko game and a video card game (claims 26 and 37); sending gaming machine identification information to the smart card (claim 31); and the game is a pull

Art Unit: 3713

tab game (claim 40) are inherently known from standard gaming machines such as used in Acres et al. .

Further, note that, by utilizing applications from Montgomery's smart card on the gaming system of Acres et al., the speaker and video display of the gaming system would certainly outputs audio/video components from the smart card (as the games being executed by the game machine).

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Montgomery's with a progressive bonus gaming system utilizing smart card, as taught by Acres et al., as an enhancement to gaming features, i.e., providing state of the art features to players, that would attract them to games and thus be profitable.

4. Applicant's arguments filed In Paper No. 10, October 16, 2003 have been fully considered but they are not persuasive. Applicant's arguments that Montgomery does not describe gaming instructions generated by a processor on the smart card or gaming instructions generated by a master gaming controller, and that Acres et al. does not describe smart card or smart card reader, are not convincing. As being addressed above, Montgomery teaches application instructions (Figs. 5C-6D) generated by a processor (72) on the smart card and (6:10-7:29; 3:29-4:67) and a terminal (82) having master controller (micro-controller 86) to control the application on the terminal and from application the smart card; further, Acres et al. teaches a gaming machine for executing a game play, with the aid of smart a card (120), comprising a master game controller

Art Unit: 3713

(2:50-3:65; 6:29-65), wherein the gaming machine is operable to receive the smart card in the smart card reader from a game player playing the game of chance on the gaming machine (1:33-48; 14:30-53; 20:30-43; 26:55-29:32). Note that, applicant's amended limitations of gaming instructions generated by the master gaming controller, and gaming machine being operable to receive the smart card in the smart card reader from a game player playing the game of chance on the gaming machine (claims 16 and 27) are met by the teaching of Acres et al. as being stated in paragraph numeral 3.

Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to use Montgomery's smart card in a gaming system utilizing smart card of by Acres et al., as an enhancement to gaming features, i.e., providing state of the art features or personalizing game features to players that would attract them to games and thus be profitable.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3713

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Teresa Walberg
Supervisory Patent Examiner
Group 3700

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